



February 9, 2005

WRITER'S DIRECT NUMBER: (202) 772-8591 INTERNET ADDRESS: IMILLS@SKGF.COM

Mail Stop: Amendment

Commissioner for Patents PO Box 1450 Alexandria, VA 22313-1450

Re: U.S. Utility Patent Application

Appl. No. 09/517,466; Filed: March 2, 2000

For: Compositions and Methods for Use In Recombinational Cloning of

Nucleic Acids

Inventor: HARTLEY et al.

Our Ref: 0942.4680003/BJD/JKM

Sir:

Transmitted herewith for appropriate action are the following documents:

- 1. Ninth Supplemental Information Disclosure Statement;
- 2. List of cited references on Form PTO-1449 (3 sheets);
- 3. Copies of references AL23, AS214, AT214 and AS216 listed on Form PTO-1449 (4 documents); and
- 4. One (1) return postcard.

It is respectfully requested that the attached postcard be stamped with the date of filing of these documents, and that it be returned to our courier. In the event that extensions of time are necessary to prevent abandonment of this patent application, then such extensions of time are hereby petitioned.

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Commissioner for Patents February 9, 2005 Page 2

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

Jeffrey K. Mills

Agent for Applicants Registration No. 56,413

RWE/BJD/JKM:bac Enclosures

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

application of:

HARTLEY et al.

ppl. No.: 09/517,466

Filed: March 2, 2000

For: Compositions and Methods for

Use in Recombinational Cloning of Nucleic Acids

Confirmation No.: 4289

Art Unit: 1634

Examiner: Johannsen, D.

Atty. Docket: 0942.4680003/RWE/BJD/JKM

Ninth Supplemental Information Disclosure Statement

Commissioner for Patents PO Box 1450 Alexandria, VA 22313-1450 Sir:

Listed on accompanying Form PTO-1449 are documents that may be considered material to the examination of this application, in compliance with the duty of disclosure requirements of 37 C.F.R. §§ 1.56, 1.97 and 1.98.

The numbering on this Ninth Supplemental Information Disclosure Statement is a continuation of the numbering in Applicants' Eighth Supplemental Information Disclosure Statement filed January 21, 2005, in connection with the above-captioned application.

Copies of documents AH20-AK20 and AA21-AG21 are not provided in accordance with the Changes To Support Implementation of the United States Patent and Trademark Office 21st Century Strategic Plan, effective October 21, 2004, which states "section 1.98(a)(2)(i) is amended to eliminate the requirement in paragraph (a)(2)(i) for a copy of each U.S. patent or U.S. patent application publication listed in an IDS in a patent application regardless of the filing date of the application."

Copies of documents AR215-AT215 and AR216 are not provided in accordance with the U.S. Patent and Trademark Office OG notice of October 19, 2004, which states: "the requirement in 37 C.F.R. § 1.98(a)(2)(iii) for a legible copy of the specification, including the claims, and drawings

of each cited pending U.S. patent application (or portion of the application which caused it to be listed) is *sua sponte* waived where the cited pending application is stored in the USPTO's IFW system." A copy of each other document is provided.

The Examiner's attention is directed to the following co-pending U.S. Patent Applications, which are directed to related technical subject matter:

- U.S. Patent Application No. 10/877,952, Welch *et al.*, filed July 28, 2004 and cited herewith as document **AR215**;
- U.S. Patent Application No. 10/913,501, Chesnut *et al.*, filed August 9, 2004 and cited herewith as document **AS215**;
- U.S. Patent Application No. 10/970,635, Hanson, filed October 22, 2004 and cited herewith as document AT215; and
- U.S. Patent Application No. 11/000,371, Chesnut *et al.*, filed December 1, 2004 and cited herewith as document **AR216**.

The identification of these U.S. Patent Applications is not to be construed as a waiver of secrecy as to these applications now or upon issuance of the present application as a patent. The Examiner is respectfully requested to consider the cited applications and the art cited therein during examination.

Where the publication date of a listed document does not provide a month of publication, the year of publication of the listed document is sufficiently earlier than the effective U.S. filing date and any foreign priority date so that the month of publication is not in issue. Applicants have listed publication dates on the attached Form PTO-1449 based on information presently available to the undersigned. However, the listed publication dates should not be construed as an admission that the information was actually published on the date indicated.

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HARTLEY *et al.* Appl. No. 09/517,466

Applicants reserve the right to establish the patentability of the claimed invention over any

of the information provided herewith, and/or to prove that this information may not be prior art,

and/or to prove that this information may not be enabling for the teachings purportedly offered.

This statement should not be construed as a representation that a search has been made, or

that information more material to the examination of the present patent application does not exist.

The Examiner is specifically requested not to rely solely on the material submitted herewith.

This Information Disclosure Statement is being filed before the mailing of a first Office

Action after the filing of a Request for Continued Examination under 37 C.F.R. § 1.114. No

statement or fee is required.

It is respectfully requested that the Examiner initial and return a copy of the enclosed Form

PTO-1449, and indicate in the official file wrapper of this patent application that the documents have

been considered.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or

credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

Mar L. Mil

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

Jeffrey K. Mills

Agent for Applicants

Registration No. 56,413

Date: <u>Feb.</u> 7, 2005 1100 New York Avenue, N.W. Washington, D.C. 20005-3934

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				U.S. PATE	NT DOCUMENTS					
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	AH20 Al20		5,040,138	03/21/2000	Lockhart et al.			09/15/1995		
			5,303,301	10/16/2001	Mack			05/29/1998		
	AJ20		5,309,822	10/30/2001	Fodor et al.			12/23/1996		
	AK20) (5,333,155	12/25/2001	Lockhart et al.			12/18/1998		
			I	FOREIGN PA	TENT DOCUMENTS					
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	AL23	'	WO 01/68836	09/20/2001	WIPO			Yes No		
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	AN							Yes No		
	AO							Yes No		
	AP							Yes No		
	OTHER (Including Author, Title, Date, Pertinent Pages, etc.)									
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Baum, J.A., "Tn5401, a New Class II Transposable Element From International Internation of thuring in thuring iensis," J. Bacteriol. 176:2835-2845, American Society for Machine (1994)										
	AT	214	Office Action for	or U.S. Patent	t Application No. 10/796,868,	mailed o	on January 2	5, 2005		
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	AA21	20	002/0162126	10/31/2002	Beach et al.			05/24/2001		
	AB21	6,5	544,790	04/08/2003	Sabatini			09/18/2000		
	AC21	20	003/0135888	07/17/2003	Zhu et al.			09/26/2002		
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	AE21	20	004/0229229	11/18/2004	Cheo et al.			08/14/2003		
	AF21			12/30/2004	Chesnut et al.			03/04/2004		
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	AR	215	U.S. Patent Application No. 10/877,952, Welch et al., filed July 28, 2004 (NOT PUBLISHED)							
	AS	215	U.S. Patent Application No. 10/913,501, Chesnut et al., filed August 9, 2004 (NOT PUBLISHED)							
	AT	<u>215</u>	U.S. Patent Appl (NOT PUBLISH		0/970,635, Hanson, filed Octo	ber 22,	2004			

EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to Applicant.

DATE CONSIDERED

EXAMINER

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	AR	<u>216</u>	U.S. Patent Application No. 11/000,371, Chesnut et al., filed December 1, 2004 (NOT PUBLISHED)						
	AS	<u>216</u>	Short, J.M. et al., "λ ZAP: a bacteriophage λ expression vector with in vivo excision properties," Nucleic Acids Research 16:7583-7600, IRL Press Limited (1988)						ision
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